

REMARKS

In the Final Office Action dated July 3, 2003, all pending claims 3 through 14 are rejected. Claims 3-8, 11, 13, and 14 are rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 1,842,226 (hereinafter referred to as “the Williams patent”). Claims 9, 10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by the Williams patent. Finally, claims 12 and 13 are objected to as having informalities.

Applicants herein amend the grammatical errors identified by the Examiner in claims 12 and 13.

With regard to the outstanding rejections of claims 3 through 14, as discussed below, Applicants respectfully request that the Examiner remove the finality of the present Office Action and reconsider all outstanding rejections in light of the following comments. The Examiner based previous claim rejections on the Williams patent in combination with other references. Applicants successfully argued the inappropriateness of such combinations. In the present final rejection, the Examiner’s basis for rejection relies solely on the Williams patent, indicating that all other limitations not found in the Williams patent are inherent.

Applicants respectfully contend that such finality is inappropriate. By presently relying solely on the Williams patent in both a 102 and 103 rejection, and arguing claim limitations not disclosed in the Williams patent as inherent, the Examiner is clearly departing from the previous rejection strategy requiring a combination of references. Further, Applicants respectfully contend that they should be given an opportunity to respond on the record to the new strategy of rejection that was available to the Examiner in the first office action, but was not presented until under final office action. Applicants believe that fairness requires an opportunity to address the Examiner’s complete reliance on the Williams patent as well as being able to address what

characteristics may or may not be inherent in the Williams patent without the unduly burdensome requirement of appeal or refilling of the application. Therefore, Applicants respectfully request that the Examiner remove the finality of the outstanding Office Action and consider the present comments in support of removal of the present rejections.

The Examiner's Section 102 rejection of claims 9, 10, and 12 and Section 103 rejection of claims 3-8, 11, 13, and 14 argues the inherent inclusion of subject matter not disclosed in the Williams patent. "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. USA v. Monsanto Co.*, 20 USPQ2d 1746,1749 (Fed.Cir. 1991).

To support such an inclusion, the Examiner must provide evidence that flash lines and surface mismatch are inherent characteristics clearly understood, albeit not disclosed, on the closure member sealing surface of the Williams patent. Applicant contends that the Examiner's conclusory statement that glass closures are known to have flash lines formed during manufacture is both inappropriate Section 102 evidence and incomplete Section 103 evidence. Applicants contend that such inherency is not supported by the Williams patent and therefore the Section 102 and 103 rejections are inappropriate.

Part line flash and surface mismatch are clearly known in industries that mold parts. Such flash and mismatch is typically caused by deteriorating dies that permit flash or mismatch to emerge and progressively worsen. As indicated in Applicants' disclosure, external product surface part line flash or surface mismatch is typically removed by a secondary machining

operation to smooth or grind the flash or mismatch to improve the exterior appearance of the product. However, if part line flash or surface mismatch occurs on a sealing surface, one skilled in the art would perform a secondary operation to remove the flash or mismatch from the sealing surface as supported by the Marchyn patent, U.S. Patent No. 2,906,429. As discussed in the previous office action response, Marchyn includes a sealing surface comprising an annular smooth surface on which the gasket seats. Although not discussed in the Marchyn patent, if flash or mismatch occurs during the molding process and such flash or mismatch occurs across the sealing surface, presumably such flash or mismatch would be polished or ground by a secondary operation to provide a smooth gasket sealing surface as required.

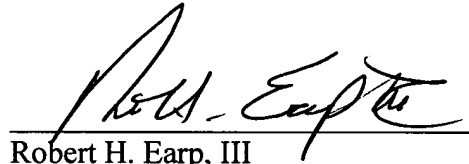
Likewise, the Williams patent does not discuss any presence of part line flash or surface mismatch on the sealing surface. Given that fact alone, it appears clear that there is no support in the Williams patent to argue that flash or mismatch is an inherent characteristic of the closure member. There is likewise no discussion of any manufacturing techniques that would clearly support the presumption that flash or mismatch would occur during manufacture. Furthermore, and most revealing regarding the inappropriateness of presuming Applicants' claimed limitations are inherent to the Williams patent, even if flash or mismatch were to normally occurring during manufacture of the Williams closure member, a predicate that cannot be presumed, there is no clear support that such flash or mismatch would occur across the sealing surface as required by Applicants claims.

Therefore, Applicants respectfully contend that the Section 102 and 103 rejections of claims 3 through 14 based solely upon the Williams patent and presumed inherent characteristics are both inappropriate and unsupported with clear extrinsic evidence. Therefore, Applicants

respectfully request that the Examiner reconsider the rejections and withdraw the Section 102 and 103 rejections and indicate the claims as allowable.

The Examiner is encouraged to call undersigned counsel should any questions or comments arise regarding the reconsideration or allowance of the claims as presented herein.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "R. H. Earp, III", written over a horizontal line.

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